



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,509	01/05/2001	Christopher Michael Welborn		5089

7590 08/18/2004

CHRISTOPHER MICHAEL WELBORN
331 SANDPIPER DRIVE
DAVIS, CA 95616

EXAMINER

HENNING, MATTHEW T

ART UNIT	PAPER NUMBER
----------	--------------

2131

4

DATE MAILED: 08/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/755,509

Applicant(s)

WELBORN ET AL.

Examiner

Matthew T Henning

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☒ Claim(s) 17 and 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01/05/01</u> . | 6) <input type="checkbox"/> Other: _____ |

This action is in response to the communication filed on 01/05/2001.

DETAILED ACTION

1. Claims 1-49 have been examined.

Title

2. The title of the invention is acceptable.

Priority

3. No claim for priority has been made for this application.
4. The effective filing date for the subject matter defined in the pending claims in this application is January 5, 2001.

Information Disclosure Statement

5. The information disclosure statement (IDS) submitted on 01/05/2001 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

Drawings

6. The drawings filed on 04/05/2001 are acceptable for examination proceedings.

Specification

7. The use of numerous trademarks such as "MICROSOFT" and "WINDOWS" has been noted in this application. They should be capitalized wherever they appear and should be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Appropriate correction is required. See MPEP § 608.01(v).

Claim Objections

8. The applicant is reminded that a series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n).

9. The claims are objected to because the lines are crowded too closely together, making reading and entry of amendments difficult. Substitute claims with lines one and one-half or double spaced on good quality paper are required. See 37 CFR 1.52(b).

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claim 15 recites the limitation "the fourth computer" in line 1. There is insufficient antecedent basis for this limitation in the claim and the claim is therefore rejected.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the

Art Unit: 2131

applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claim 1, 3-7, 19, 32-34 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Venkatraman et al. (U.S. Patent Number 6,014,688) hereinafter referred to as Venkatraman.

14. Claim 1 recites an e-mail user behavior modification system for computer virus avoidance, an e-mail system with users each with an e-mail address and a first, second, and third computer in a computer network, wherein the e-mail user behavior modification system provides: means for a first computer to select a set of e-mail addresses from an e-mail directory (See Venkatraman Fig. 5 which depicts a list of multiple recipients wherein it was inherent that the recipients were selected in order for the list of recipients to have existed); means for the first computer to transmit the set of e-mail addresses to a second computer in the computer network (it was inherent that the list of recipients depicted in Fig. 5 of Venkatraman was sent to the computer used for e-mailing in order for the e-mail to be received by the recipient's in the list); means for the second computer to send an e-mail with a mock computer virus attachment to a user with an e-mail address in the set of e-mail addresses (See Venkatraman Col. 6 Paragraph 5 – Col. 7 Paragraph 1 wherein it was inherent that the e-mail was sent to the recipients in the list of recipients in order for the recipients to receive the e-mail as required by the system of Venkatraman); means for the mock computer virus attachment when opened by a user, to send an e-mail to the e-mail address of a third

computer indicating that the mock virus attachment was opened by the user (See Venkatraman Fig. 15 Elements 136, 138, 144, 150, and 152, and Col. 8 Lines 27-30); means for the third computer to compile a list of users with e-mail addresses that opened the mock computer virus attachment (it was inherent that a list of addresses who triggered the event Element 136 was compiled via the receipt of return receipt e-mails in the specified addresses inbox).

15. Claim 6 recites that the first computer, the second computer, and the third computer are the same computer (See Fig. 1 Element 20 and Col. 8 Lines 27-30 wherein the sending computer received the receipts).

16. Claims 3-5 are rejected for the same reasons as claim 4 above.

17. Claim 7 recites that the list of users with e-mail addresses that opened the mock computer virus attachment is accessible as a web page or sent as an e-mail (See Venkatraman Col. 8 Paragraph 4).

18. Regarding claim 19, it was inherently natural that in having a list of users who accessed the attachment (See rejection of claim 1 above), the inbox also contained a list of users that did not access the attachment.

19. Claim 32 is rejected for the same reasons as claim 1 above, and further because Venkatraman disclosed the use of software to implement the e-mail system (See Venkatraman Detailed Description Paragraph 1).

20. Claims 33, 34, and 37 are rejected for the same reasons as claim 1 above.

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claim 8 rejected under 35 U.S.C. 103(a) as being unpatentable over

Venkatraman as applied to claim 1 above, and further in view of Fischer (U.S. Patent number 5,311,591).

Venkatraman disclosed a system for sending e-mails with automatically executing attachments and automatic receipts (See rejection of claim 1 above), but failed to disclose the system requiring authorization in order to send the e-mails.

Fischer teaches that in order to prevent the spread of viruses, authorization should be provided prior to sending electronic mail (See Fischer Col. 13 Paragraphs 3-4 and Col. 3 Paragraph 3).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teachings of Fischer to the E-mail program of Venkatraman in order to authorize the sending of electronic messages. This would have been obvious because the ordinary person skilled in the art would have been motivated to prevent the unintentional spread of computer viruses.

23. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Venkatraman as applied to claim 1 above, and further in view of Moraes (U.S. Patent Number 6,014,502).

Venkatraman disclosed a system for sending e-mails with automatically executing attachments and automatic receipts (See rejection of claim 1 above), but failed to disclose determining of the number of recipients of the message.

Moraes teaches that in an e-mail system, advertisements can be displayed in e-mails and the number of viewers of an advertisement can be used to bill an advertiser (See Moraes Col. 6 Paragraph 3).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teachings of Moraes in the e-mail system of Venkatraman in order to display advertisements in e-mails. This would have been obvious because the ordinary person skilled in the art would have been motivated to provide the recipients with advertisements targeted toward their interests (See Moraes Col. 5 Paragraph 2).

24. Claims 2, 10-18, 20-31, 35-36, and 38-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Venkatraman and Moraes.

25. Regarding claim 2, Moraes disclosed sending the e-mails over the Internet (See Moraes Col. 3 Paragraph 6 and Col. 1 Paragraph 7).

26. Regarding claim 10, Moraes disclosed billing based on the number of viewers of an advertisement (See Moraes Col. 20 Lines 52-56).

27. Claims 11 and 12 are rejected for the same reasons as claims 9 and 10 above.
28. Claims 13 and 14 are rejected for the same reasons as claims 9 and 10 above.
29. Regarding claim 15, Moraes disclosed targeting recipients with specific types of emails (See Moraes Col. 5 Paragraph 3).
30. Regarding claim 16, Moraes disclosed billing determined by the advertisements shown to users (See Moraes Col. 6 Paragraph 3).
31. Regarding claims 17 and 18, Moraes disclosed billing based on accesses to the event log and advertisement statistics file (See Moraes Col. 20 Lines 50-56).
32. Claim 20 is rejected for the same reasons as claim 10 above.
33. Regarding claims 21-23, Moraes disclosed changing the advertisements periodically (See Moraes Col. 5 Paragraph 6), and that the advertisements were chosen (authorized) for each user by the system (See Moraes Col. 7 Paragraph 3).
34. Regarding claim 24, Moraes disclosed billing based on the number of advertisements viewed (See Moraes Col. 6 Paragraph 4).
35. Claims 25-28 are rejected for the same reasons as claims 21-24 above.
36. Regarding claim 29, Moraes disclosed directly sending billing information over a network (See Moraes Col. 23 Paragraph 4).
37. Regarding claim 30, Moraes disclosed indirectly sending billing information over a network (See Moraes Col. 23 Paragraph 4).
38. Claim 31 is rejected for the same reasons as claim 18 above.
39. Claim 35 is rejected for the same reasons as claim 32 above and further because Moraes disclosed the providing the necessary software to the user over the Internet

(See Moraes Col. 10 Paragraph 7). It was inherent that a server provided the program in order for it to have been downloaded.

40. Claim 36 is rejected for the same reasons as claim 35 above.

41. Claims 38-49 are rejected for the same reasons as claim 35 above.

Conclusion

42. Claims 1-49 have been rejected.

43. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Fischer (U.S. Patent Number 5,390,247) disclosed a system of traveling programs which e-mails itself to another address after being executed.

b. Coley et al. (U.S. Patent Number 5,826,014) disclosed a proxy firewall for regulating access to an e-mail or web server and a public network.

c. Birrell et al. (U.S. Patent Number 6,185,551) disclosed a web based e-mail system.

d. Flynn et al. (U.S. Patent Number 6,618,747) disclosed an e-mail system with delivery confirmation.

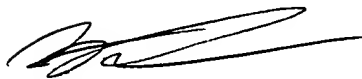
e. Veljkov et al. ("Pocket guide to the Internet Volume 4") disclosed background information about e-mail and the internet.

Art Unit: 2131


44. Please direct all inquiries concerning this communication to Matthew Henning whose telephone number is (703) 305-0713. The examiner can normally be reached Monday-Friday from 9am to 4pm, EST.

If attempts to reach examiner by telephone are unsuccessful, the examiner's acting supervisor, Ayaz Sheikh, can be reached at (703) 305-9648. The fax phone number for this group is (703) 305-3718.

Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



Matthew Henning
Assistant Examiner
Art Unit 2131



EMMANUELL L. MOISE
PRIMARY EXAMINER
4/11 2/36